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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,844	08/19/2003	Jean-Claude Lancien	6980-01	4918

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EXAMINER

BOCHNA, DAVID

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/643,844

Applicant(s)

LANCIEN, JEAN-CLAUDE

Examiner

David E. Bochna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-10 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 5-6 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by de Lange 4,488,739.

In regard to claim 1, de Lange discloses a spacer for putting into place on a tubular element, the spacer comprising firstly a sleeve 4 of high-compressibility cellular material 22, said sleeve presenting a wide slot extending over its entire length and defining a central passage that is essentially cylindrical (fits around cylindrical pipes 9, 10 and 19), of diameter greater than the nominal diameter of the tubular element, and secondly a sheath of heat-shrink plastics material 27, 28, 12 surrounding the split sleeve at least as far as the end edges thereof, said sheath being partially shrunk on the split sleeve firstly (the sleeve is created to be a certain size before assembly) so as to hold said split sleeve in the open state for putting the spacer into place on the tubular element, and secondly so as to be able subsequently to be heat-shrunk to clamp said split sleeve and fix said spacer in position.

In regard to claim 2, wherein the sleeve presents a slot that extends axially (see fig. 5).

In regard to claim 5, wherein the partially-shrunk sheath overlaps the end edges of the split sleeve at least in part (see fig. 4, where 27, 28 and 12 extend past 4).

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In regard to claim 6, wherein the sheath extends beyond at least one of the end edges of the split sleeve, forming a cylindrical lip of inside diameter greater than the nominal diameter of the tubular element (see fig. 4, where 27, 28 and 12 extend past 4).

In regard to claim 8, wherein the outside of the sheath presents identification marking and/or color (the sheath will inherently have some color that will identify it).

In regard to claim 9, wherein the split sleeve is made of closed-cell cellular foam (its made of foam polyurethane).

In regard to claim 10, wherein the sheath is made of plastics material that is both a heat-shrink material and suitable for providing the split sleeve with mechanical and/or chemical protection (the sheath is polyethylene or polypropylene, which provides some amount of mechanical protection).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over de Lange '739.

De Lange discloses a sleeve with a slot as described above, but does not disclose that the slot extends obliquely or helically. However, changing the shape of the slot from an axial slot to that of a helically slot would have been obvious to a person having ordinary skill in the art because a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). The present application provides no reason why the helical slot has any patentable significance. Thus, changing the shape of the slot in de

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Lange from an axial cut to that of a helically slot would have been obvious to one of ordinary skill the art.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over de Lange '739 in view of Lever. De Lange et al. discloses a spacer as described above, but does not disclose that the sheath stops at the edges of the split sleeve. However, it would have been obvious to a person having ordinary skill in the art to end the sheath of de Lange at the end of the split sleeve because the practice of ending a sheath at the end of a sleeve is common and well known in the art as demonstrated by Lever, Winterhoff et al. and Japanese Patent 4,342,820.

***Allowable Subject Matter***

6. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

7. Applicant's arguments filed on 12/27/04 have been fully considered but they are not persuasive.

Applicant argues that de Lange fails to disclose a sleeve of high-compressibility cellular material. The Examiner disagrees. de Lange discloses a polyurethane foam plastic, which is a cellular material and the limitation "high-compressibility" is a relative term. The polyurethane material disclosed by de Lange could be considered highly compressible when compared to certain other materials such as that of the metal.

Applicant also argues that the cellular material of de Lange can not be highly compressible because of the reference to the de Lange that "in order to bend the insulating pipe part section 2 and 3 outwardly along slit 5, the walls 23 and 24 of the insulating pipe parts 2 and

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3 must be thin". However, this statement only proves that the sleeve is flexible in the areas 23 and 24. Again, the polyurethane sleeve of de Lange has "high compressibility" relative to other types of materials.

Applicant also argues that de Lange fails to disclose a sheath of heat-shrink plastics material surrounding the split sleeve at least as far as the end edges thereof. The Examiner disagrees. Looking at fig. 3, it can be seen that sheathes 6 and 7 surround the split sleeve at least as far as the end edges thereof. Sleeve 6 surrounds the end of the sleeve in the area where 27 is pointing in fig. 4, and also extends past the sleeve end. Claim 1 does not require the sheath to cover the entire exterior surface of the sleeve.

Applicant also argues that de Lange fails to disclose partially shrinking the sheath onto the split sleeve. The Examiner disagrees. The sheath of de Lange is placed on the sleeve and then shrunk until the sleeve is pulled tight against the exterior of the pipe. In that process the sheath is partially shrunk at some point. The remaining recitation of claim 1, "firstly so as to hold said split sleeve in the open state for putting the spacer into place on the tubular element and secondly so as to be able subsequently to be heat-shrunk to clamp said split sleeve and fix said spacer in position" is considered intended use and is given little patentable weight as long as the applied prior art is capable of fulfilling the same intended use. In this case, the sheath of de Lange is capable of holding the sleeve in a open position when partially shrunk, and therefore anticipates the recited claim.

Because it is believed that de Lange anticipates claim 1, the rejections of claims 3 and 4 are being maintained.

*Conclusion*

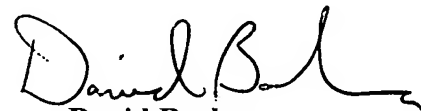
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Bochna whose telephone number is (703) 306-9040. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



**David Bochna**  
**Primary Examiner**  
**Art Unit 3679**  
**April 7, 2005**